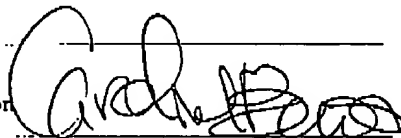



DEC 22 2005

PTO/SB/33 (07-05)

PRE-APPEAL BRIEF REQUEST FOR REVIEW	
CERTIFICATE OF TRANSMISSION I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office Fax No. (703) 305-8568 on <u>12/22/2005</u> Signature <u></u> Typed or printed name <u>Caroline Benson</u>	
Docket Number (Optional) A1320Q1-US-NP	
Application Number 09/683,240	Filed December 5, 2001
First Named Inventor James G. Shanahan	
Art Unit: 2178	Examiner Joshua D. Campbell
Customer Number: 25453	
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attach sheet(s). Note: No more than five (5) pages may be provided. I am the <input checked="" type="checkbox"/> Attorney or Agent of record. Registration number 37,481 <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34 Registration number if acting under 37 CFR 1.34. <div style="text-align: right;"><u></u> Signature Thomas Zell Typed or Printed name 650-812-4281 Telephone Number 12/16/2005 Date</div>	

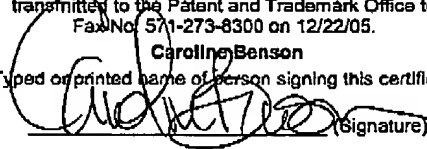
☒ Total of 1 forms are submitted. 305-8568

11/2005

RECEIVED
CENTRAL FAX CENTER

DEC 22 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

<p style="text-align: center;">CERTIFICATE OF TRANSMISSION</p> <p>I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office to Fax No. 571-273-8300 on 12/22/05.</p> <p style="text-align: center;">Caroline Benson (Typed or printed name of person signing this certificate)</p> <p style="text-align: center;"> (Signature)</p>
--

Application No. : 09/683,240
Filed : 12/05/2001
Inventor(s) : James G. Shanahan et al.
Docket No. : A1320Q1-US-NP
Confirmation No. : 8313
Examiner : Joshua D. Campbell
Art Unit : 2178
Title : META-DOCUMENT MANAGEMENT SYSTEM WITH
TRANSIT TRIGGERED ENRICHMENT
Customer No. : 25453

MAIL STOP AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant respectfully requests a pre-appeal review of this application, which was finally rejected in an Office Action dated September 22, 2005 and for which a Response And Request For Reconsideration was filed November 22, 2005, and in response to which an Advisory Action was mailed December 9, 2005. Cross-reference is made to U.S. Patent Application Serial No. 09/683,239 for which a Pre-Appeal Brief Request For Review is being simultaneously filed on similar grounds.

The Office Action rejects claims 1-6, 10-15, and 19-20 under 35 USC 103(a) as being unpatentable over Horowitz et al., U.S. Patent 6,122,647 (hereinafter "Horowitz") in view of Goodisman et al., U.S. Patent Application Publication 2002/0069223 (hereinafter "*Goodisman 2001*"), rejects claims 7 and 16 under 35 USC 103(a) as being unpatentable over Horowitz in view of Goodisman as applied

Application No. 09/683,240

to claims 1 and 10, and further in view of Keith JR, U.S. Patent Application Publication 2002/0032672, and rejects claims 8, 9, 17, and 18 under 35 USC 103(a) as being unpatentable over Horowitz in view of Goodisman as applied to claims 1 and 10, and further in view of Nehab et al., U.S. Patent 6,029,182.

Goodisman 2001 claims priority to Provisional Patent Application Serial No. 60/249498, filed November 17, 2000 (hereinafter "*Goodisman 2000*" or "*Goodisman Provisional*").

The Office Action relies on paragraphs 0024-0027 of *Goodisman 2001*, which paragraphs are not disclosed in *Goodisman 2000*, in rejecting Applicant's claims (see Office Action on: page 3, lines 7-8; and page 4, line 10).

In view of the non-disclosure of paragraphs 0024-0027 in *Goodisman 2000*, Applicant respectfully submits that paragraphs 0024-0027 disclosed in *Goodisman 2001* filed October 3, 2001 may not be relied on as prior art under 35 USC 103(a) in rejecting Applicant's invention, because Applicant's claimed invention is entitled to a priority date of August 13, 2001.

Also, if as maintained in the Advisory Action on page 2, line 2 that "the information relied upon in [*Goodisman 2001*] is indeed indicated in [*Goodisman 2000*]", then those sections of *Goodisman 2000* should be cited in rejecting Applicant's invention in lieu of paragraphs 0024-0027 of *Goodisman 2001*, which are not disclosed in *Goodisman 2000*.

Applicant therefore respectfully requests in view of the forgoing that the final rejection of claims 1-20 be withdrawn and restated to not rely on portions of *Goodisman 2001* which were not disclosed in *Goodisman 2000*.

Furthermore, Applicant respectfully submits that claims 1-20 are allowable for the reasons set forth in section 1.B of the Response And Request For Reconsideration, which sets forth starting on page 3 the following:

[] Applicant's invention recited in independent claim 1, 10, and 19 set forth, respectively, a method, apparatus and article of manufacture therefor, for enriching documents by invoking a print command from a print client interface (as shown in Figures 8 and 9) that allows selection of print property settings and properties of a

Application No. 09/683,240

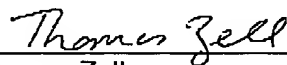
document service request (see reference number 802). Further, Applicant's claimed invention recited in independent claims 1, 10, and 19 recites the *enrichment of document content at an insertion point that identifies a processing stage in printing the document content* (see reference number 906 in Figure 9), which document content is defined by a document property included in the document service request (see reference number 808 in Figure 8) and annotated according to the enrichment theme of the personality identified by a personality identifier (see reference numbers 804 and 806 [in Figure 8]) included in an enrichment property of the document service request.

That is, Horowitz [] discloses a method for creating contextual hyperlinks in a text document [] and Goodisman Provisional [] discloses a method for integrating wireless web/Internet with java-based application servers [] fail to disclose or suggest whether taken singly or in combination Applicant's method, article of manufacture and apparatus therefore, recited in claims 1, 10, and 19 that includes *a print client interface for invoking a print command* that allows selection of print property settings and properties of a document service request, *where the document service request includes at least one document property and one enrichment property*, and that recites a meta-document server that enriches document content at an insertion point, *where the insertion point identifies a processing stage of the print command invoked from the print client interface*.

Accordingly, for the reasons stated above, Applicant respectfully requests a pre-appeal review to reopen prosecution.

Respectfully submitted,

Telephone: 650-812-4281
Date: 12/16/05



Thomas Zell
Attorney for Applicant(s)
Registration No. 37,481